

## REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated January 31, 2005, are respectfully requested.

The applicants confirm the election of claims 4-8, and 21-41. Claims 4-8 and 21-40 are hereby amended.

### A. Rejections under 35 U.S.C. § 102

#### 1. The Applied Art

Claims 4-8 and 21-41 are rejected under 35 U.S.C. § 102(b) as being anticipated by "Z-Cardz The Game!" from California Creations.

#### 2. Analysis<sup>1</sup>

Regarding claim 41, this claim recites, among other limitations, a "toy" that includes "at least two base parts and at least one function part," where the function part "is configured to be manually attached to the assembled base parts, and wherein the function part is employed under the rules of play." The Z-Cardz's reference fails to disclose such a combination of limitations, including a portion of the toy that is employed under the rules of play. Instead, the whole toy under Z-Cardz is apparently used in the Z-Cardz game.

As is known, to anticipate a claim under 35 U.S.C. §102, the reference must teach every element of the claim.<sup>2</sup> For at least the above reason, the applicants

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<sup>1</sup> Silence regarding a position taken by or argument made by the Examiner does not indicate any acquiescence to that position or argument. Furthermore, arguments made with respect to a particular claim or claims apply only to that claim or claims, and not to other claims, unless specifically noted herein.

<sup>2</sup> MPEP section 2131, p. 70 (Feb. 2003, Rev. 1). See also, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990) (to establish a *prima facie* case of anticipation, the Examiner must identify where "each and every facet of the claimed invention is disclosed in the applied reference."); *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995) (anticipation requires that each claim element must be

respectfully submit that a *prima facie* case has not been established with respect to claim 41.

Regarding independent claims 4 and 21, attorneys for the applicants apologize for the inartful drafting of these claims, and such claims have been amended to clarify aspects of the invention. The claims, as amended, more directly associate the recited structure with the functionality associated with such structure. The Z-Cardz reference does provide for models that may be assembled by hand, but components or portions of the models are not removed during game play. Thus, the process performed by using the models of Z-Cardz does not require players to remove portions of a model, or replace portions with other portions.

In response to the Board opinion Ex Parte Breslow, 192 U.S.P.Q. 431 (Pat. & Tr. Office Bd. App., 1975) cited in the office action, attorneys for the applicants respectfully bring to the Examiner's attention two more recent cases. In the case In re Gulack, 703 F.2d 1381 (Fed. Cir. 1983), the Federal Circuit stated that:

Differences between an invention and the prior art cited against it can not be ignored merely because those differences reside in the content of the printed matter. Under Section 103, the Board can not dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.

In the case In re Levin, slip op. at 4, Civ. App. 96-1180 (Fed. Cir. Feb. 3, 1997) (unpublished), the Federal Circuit stated that "a new and unobvious functional relationship must exist between the claimed combination of printed matter and other claimed elements." Under the invention of amended claims 4 and 21, any printed matter is related to functional aspects of the associated structure. In other words, any printed matter relates to intended functional operation of the models.

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identical to a corresponding element in the applied reference); *Atlas Powder Co. v. E.I. duPont De Nemours*, 750 F.2d 1569, 1574 (1984) (the failure to mention "a claimed element (in) a prior art reference is enough to negate anticipation by that reference").

However, even apart from such printed matter, components of the models are constructed so as to be readily removed during game play. While components of Z-Cardz may be able to be removed, a detailed review of the rules reveals no indication that such components have been configured for such manual removability under game play. For at least the above reasons, the applicants respectfully submit that independent claims 4, 21 and 41 are patentable. Since these claims are patentable, the claims which depend from them are likewise patentable.

B. Rejections under 35 U.S.C. § 103

1. The Applied Art

Claims 4-8 and 21-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over "Z Cardz The Game!" in view of ex. parte Breslow, 192 USPQ 431.

2. Analysis

The Z-Cardz's reference does not disclose or suggest removing game components or portions of a model during play (or replacing such components during play). Thus, in addition to the arguments presented above, the applicants respectfully submit that claims 4-8 and 21-41 are patentable.

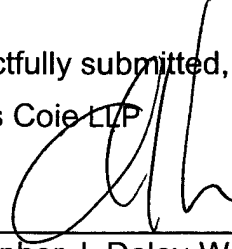
C. Conclusion

Overall, none of the applied references, singly or in any motivated combination, teach or suggest the features recited in independent claims 4, 21 and 41, and thus such claims are allowable. Since these independent claims are allowable, based on at least the above reasons, the claims which depend from them are likewise allowable. If the undersigned attorney has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or

believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3599.

Respectfully submitted,  
Perkins Coie LLP



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